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Re: Application No. 09/921,020 Attorney Docket No: RSW920010065US1	
Date: Thursday, April 28, 2005	
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: **Chastain et al.**Serial No.: **09/921,020**Filed: **August 2, 2001****For: Method and System for  
Automated Research Using Electronic  
Book Highlights and Notations****36736**PATENT TRADEMARK OFFICE  
CUSTOMER NUMBERGroup Art Unit: **2173**Examiner: **Hailu, Tadesse**Attorney Docket No.: **RSW920010065US1****Certificate of Transmission Under 37 C.F.R. 81.8(a)**I hereby certify this correspondence is being transmitted via facsimile to  
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By:

Carrie Parker  
Carrie Parker**TRANSMITTAL DOCUMENT**Commissioner for Patents  
P.O. Box 1450  
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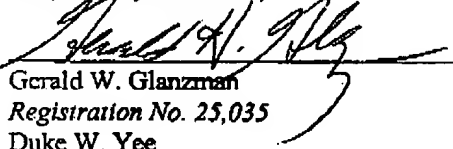
Sir:

ENCLOSED HERewith:

- Appeal Brief (37 C.F.R. 41.37).

A fee of \$500.00 is required for filing an Appeal Brief. Please charge this fee to IBM Corporation Deposit Account No. 09-0461. No additional fees are believed to be necessary. If, however, any additional fees are required, I authorize the Commissioner to charge these fees which may be required to IBM Corporation Deposit Account No. 09-0461. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0461.

Respectfully submitted,

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Docket No. RSW920010065US1

PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Chastain et al.

Serial No. 09/921,020

Filed: August 02, 2001

For: Method and System for  
Automated Research Using Electronic  
Book Highlights and Notations§  
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Group Art Unit: 2173

Examiner: Hailu, Tadesse

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on April 28, 2005.

By:

Carrie Parker

Carrie Parker

## APPEAL BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of the Notice of Appeal, filed in this case on March 4, 2005.

The fees required under § 41.20(B)(2), and any required petition for extension of time for filing this  
brief and fees therefore, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

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(Appeal Brief Page 1 of 29)  
Chastain et al. - 09/921,020

**REAL PARTY IN INTEREST**

The real party in interest in this appeal is the following party: International Business Machines Corporation.

**RELATED APPEALS AND INTERFERENCES**

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

**STATUS OF CLAIMS**

**A. TOTAL NUMBER OF CLAIMS IN APPLICATION**

Claims in the application are: 1-7, 9-16 and 18-21

**B. STATUS OF ALL THE CLAIMS IN APPLICATION**

1. Claims canceled: 8 and 17
2. Claims withdrawn from consideration but not canceled: NONE
3. Claims pending: 1-7, 9-16 and 18-21
4. Claims allowed: NONE
5. Claims rejected: 1-7, 9-16 and 18-21
6. Claims objected to: NONE

**C. CLAIMS ON APPEAL**

The claims on appeal are: 1-7, 9-16 and 18-21

**STATUS OF AMENDMENTS**

Amendments to the specification made in the Response to Final Office Action, dated February 7, 2005 have been entered. The claims were not amended in the Response to Final Office Action.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

#### **A. CLAIM 1 - INDEPENDENT**

The subject matter of claim 1 is directed to a method in a data processing system (100, 200, 300 and 410) for researching text in an electronic book (420, **Figure 5**). After the electronic book is displayed, a user input is received selecting text from the electronic book by tagging a beginning point and ending point of any portion of text in the electronic book to form selected text (424, 428, 429) (see *Specification*, page 11, paragraph beginning on line 4). In response to receiving the user input, a search (430) is automatically initiated for at least one item relevant to the selected text (see *Specification*, page 8, lines 23 through page 9, line 1 and page 13, lines 20-26; and **Figure 4**).

#### **B. CLAIM 11 - INDEPENDENT**

The subject matter of claim 11 is directed to a method in a data processing system (100, 200, 300 and 410) for searching text (424, 428, 429). The method provides a step for designating the text to use in a search (430) based on a user selected beginning point and a user selected ending point of any portion of text located in an electronic document (420, **Figure 5**) (see *Specification*, page 11, paragraph beginning on line 4). Responsive to designating the text in the electronic document to use in the search, the method provides a step for placing the text in a data structure. The data structure is a search profile (440, 445). The method provides a step for transmitting the data structure to a search engine (450, 455) and then provides a step for receiving the results (460, 465) from the search engine (see *Specification*, page 14, line 19 through page 15, line 3 and **Figure 4**).

#### **C. CLAIM 18 - INDEPENDENT**

The subject matter of claim 18 is directed to a data processing system (100, 200, 300 and 410) for researching text (424, 428, 429) in an electronic book (420, **Figure 5**). The data processing system provides a means for displaying the electronic book. After the electronic book is displayed, the data processing system provides a means for receiving a user input selecting the text from the electronic book, wherein the user input tags a beginning point and ending point of



any portion of text in the electronic book to form selected text (see *Specification*, page 11, paragraph beginning on line 4). In response to receiving the user input, the data processing system automatically initiates a search (430) for at least one item relevant to the selected text (see *Specification*, page 8, lines 23 through page 9, line 1 and page 13, lines 20-26; and Figure 4).

#### **D. CLAIM 19 - INDEPENDENT**

The subject matter of claim 11 is directed to a data processing system (100, 200, 300 and 410) for searching text (424, 428, 429). The data processing system provides a means for designating the text to use in a search (430) based on a user selected beginning point and a user selected ending point of any portion of text located in an electronic document (420, Figure 5) (see *Specification*, page 11, paragraph beginning on line 4). Responsive to designating the text in the electronic document to use in the search, the data processing system provides a means for placing the text in a data structure. The data structure is a search profile (440, 445). The data processing system provides a means for transmitting the data structure to a search engine (450, 455) and then provides a means for receiving the results (460, 465) from the search engine (see *Specification*, page 14, line 19 through page 15, line 3 and Figure 4).

#### **E. CLAIM 20 - INDEPENDENT**

The subject matter of claim 20 is directed to a data processing system (100, 200, 300 and 410) comprising a bus system (206, 306, 314), a communication unit, a memory (209, 304, 324) and a processing unit (202, 204, 302). The communication unit is connected to the bus system. The memory is connected to the bus system and includes a set of instructions. The processing unit executes the set of instructions. The set of instructions include instructions for receiving a user input selecting text (424, 428, 429) from an electronic book (420, Figure 5), wherein the user input tags a beginning point and ending point of any portion of text in the electronic book to form selected text and the selected text is identified by a user after the electronic book is displayed (see *Specification*, page 11, paragraph beginning on line 4). The set of instructions also includes instructions for automatically initiating a search (430) for at least one item relevant to the selected text in response to receiving the user input (see *Specification*, page 8, lines 23 through page 9, line 1 and page 13, lines 20-26; and Figure 4).

**F. CLAIM 21 - INDEPENDENT**

The subject matter of claim 21 is directed to a computer program product in a computer readable medium (100, 200, 300 and 410) for researching highlighted text (424, 428, 429) in an electronic book (420, Figure 5). The computer program product provides instructions for receiving a user input selecting text from the electronic book, wherein the user input tags a beginning point and ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed (see *Specification*, page 11, paragraph beginning on line 4). The computer program product provides instructions for automatically initiating a search (430) for at least one item relevant to the selected text in response to receiving the user input (see *Specification*, page 8, lines 23 through page 9, line 1 and page 13, lines 20-26; and Figure 4).

**G. CLAIM 7 - DEPENDENT**

The subject matter of claim 7, which depends from claim 1, is directed to a method wherein the selected text is a notated passage of text in the electronic book and wherein the notated passage of text is a user created note (429) associated with at least a portion (428) of the electronic book (420, Figure 5) (see *Specification*, page 13, line 26-28 and page 14, lines 6-18).

**H. CLAIM 12 - DEPENDENT**

The subject matter of claim 12, which depends from claim 11, is directed to a method wherein the text includes a user created note (429) associated with the text (428) (see *Specification*, page 13, line 26-28 and page 14, lines 6-18).

**GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

**A. GROUND OF REJECTION 1 (Claims 1-7, 9-16 and 18-21)**

Claims 1-7, 9-16 and 18-21 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Graham et al.* (U.S. Patent Number 6,457,026 B1).

## **ARGUMENT**

### **A. GROUND OF REJECTION 1 (Claims 1-7, 9-16 and 18-21)**

Claims 1-7, 9-16 and 18-21 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Graham et al.* (U.S. Patent Number 6,457,026 B1), hereinafter referred to as *Graham*. This rejection is respectfully traversed.

#### **A.1. Claims 1-6, 9-10, 18, 20 and 21**

As to independent claims 1, 18, 20 and 21, the Final Office Action states:

With regard to claims 1, 18 and 21:

*Graham et al.* ("Graham") discloses a computer-implemented method for researching highlighted or annotated text in an electronically stored document (or electronic book), which contains plurality of pages including table of contents (see Figs. 2A-2D, 3, 4, 9A and 9B).

The method includes among other things, receiving a user input via an input device (Fig. 1, #36) selecting the text from the electronic document to form selected text (see Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226, column 3, lines 56-66, column 4, lines 3-28).

The method also includes automatic web search process (automatically initiating a search), wherein when this web search process is enabled (via user input), whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web search tool such as Alta Vista<sup>TM</sup> is employed to look on the World Wide Web for documents containing the keyword (the selected text) or key phrase (column 7, lines 46-57). ...

With regard to claims 20:

*Graham* discloses a data processing system (Fig. 1, #10) comprising: a bus system (12); a communication unit (40) connected to the bus system; a memory (16) connected to the bus system, wherein the memory includes a set of instructions.

*Graham* further discloses a processing unit (14) connected to the bus system, wherein the processing unit executes the set of instruction to receiving a user input (30 and 36) selecting the text from the electronic book to form selected text (see Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226).

*Graham* also discloses automatic web search process (automatically initiating a search) (column 7, lines 46-57), wherein when this web search process is enabled (via user input), whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web search tool such as Alta Vista<sup>TM</sup> is employed to look on the World Wide Web for documents containing the keyword (the selected text) or key phrase (column 7, lines 46-57). ...

Applicant's arguments filed September 24, 2004 have been fully considered but they are not persuasive. Applicant argues that Graham does not teach or suggest every element of the claimed invention. The Applicant further specifies, Graham does not teach or suggest the "receiving" step as recited in independent claims 1, 18, 20 and 21. The Applicant further strongly argues that Graham provides no ability for a user to select a portion of a displayed electronic book, by tagging a beginning point and an end point ..."

The Examiner strongly disagrees because it is Graham who teaches tagging beginning point and an end point, or special tags around particular words or phrases (column 8, lines 13-31) not the present invention. The present invention merely describes tagging. The relevant portion of the disclosure (page 13, line 20 through page 14, line 8) reads, "The tagging of the highlighted passage for searching may be initiated using a number of different mechanisms." The relevant portion of the disclosure also reads "This not also may be tagged for research in these examples."

The Applicant also argues that Graham does not teach or suggest that a user can select any portion of text from an electronic document after the electronic document is displayed and automatically searching for items relevant to the selected text in response to the user input selecting the text. The Examiner disagrees because as given rejection above and as described in column 7, lines 26 – column 8, lines 12, Graham describes the limitation.

Final Office Action dated December 7, 2004, pages 3-4 and pages 8-9.

Claim 1, which is representative of the other rejected independent claims 18, 20 and 21 with regard to similarly recited subject matter, reads as follows:

1. A method in a data processing system for researching text in an electronic book, the method comprising:  
receiving a user input selecting the text from the electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed; and  
automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input. (emphasis added)

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that *Graham* does not identically show every element of

the claimed invention arranged as they are in the claims. Specifically, *Graham* does not teach or suggest receiving a user input selecting the text from an electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed. Additionally, *Graham* does not teach or suggest automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input, as recited in independent claims 1, 18, 20 and 21.

*Graham* is directed toward an automatic reading assistance application for documents in electronic form. An automatic annotator finds concepts of interest and keywords in an electronic document based on the contents of a user profile. The concepts of interest and other user-specific information are maintained in a user profile. The user employs a profile editor to modify the contents of the user profile. When a user opens an electronic document, the electronic document is automatically annotated. Concepts of interest and keywords contained in the user profile are automatically highlighted when the electronic document is opened. *Graham* does not teach the features as recited in claims 1, 18, 20 and 21.

Claims 1, 18, 20 and 21 of the present application recite automatically initiating a search for at least one item relevant to selected text in response to receiving a user input selecting a beginning point and ending point of an portion of text within an electronic document. After an electronic book is displayed, a user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text. The selected text is identified by a user after the electronic book is displayed. To the contrary, *Graham* teaches highlighting keywords in an electronic document based on the contents of a user profile. In *Graham*, the electronic book is highlighted in response to opening the electronic book. Further, *Graham's* web autofetch feature only searches for keywords in a user profile. *Graham* provides no ability for a user to select a portion of a displayed electronic book, by tagging a beginning point and an end point, and then initiate a search for an item relevant to the selected portion of text. To the contrary, *Graham* teaches a different operation in which portions of a displayed text that are relevant to a user profile are highlighted automatically.

The Final Office Action refers to the following portion of *Graham* in the rejection of independent claims 1, 18, 20 and 21:

FIG. 2B depicts the document view of FIG. 2A but with annotation added in first viewing area 202. Phrases 220 have been highlighted to indicate that they relate to concepts of interest to the user. The highlighting is preferably color. However, for case of illustration in black-and-white format, rectangles indicate the highlighted areas of text. For further emphasis, the highlighted text is preferably printed in bold. A rectangular bar 222 indicates a paragraph that has been determined to have relevance above a predetermined threshold or to have more than a threshold number of key phrases. Rectangular bar 222 is merely representative of various forms of marginal annotation that might be used to indicate a relevant section of the text.

FIG. 2C depicts an alternative style of annotation. Now in first viewing area 202, entire sentences 224 including phrases relevant to concepts of interest are highlighted. The phrases themselves are printed in bold text. It has been found that highlighting the entire sentence rather than just a relevant phrase provides the user with far more information at a glance.

FIG. 2D depicts how further information about key phrases may be displayed. The user may select any highlighted key phrase with the mouse. Upon selection of the key phrase, a balloon 226 appears. The balloon includes further information relevant to the key phrase. For example, the balloon may include the name of the concept to which the keyword is relevant. The balloon may also include bibliographic information if the key phrase includes a citation.

FIG. 3 depicts a document summary view in accordance with one embodiment of the present invention. The user may optionally select a summary view 300 of the document. Summary view lists the concepts of interest 302 that are found in the documents as headings of an outline. For each concept, keywords or key phrases 304 are listed which are indicative of the concept of interest. A number in parenthesis by each keyword indicates the number of times the keyword or key phrase appears. Each concept also has an associated score 306 indicative of the relevance of the whole document to the concept.

*Graham*, column 3, line 56 through column 4, line 28. (emphasis added)

This portion of *Graham* teaches that the automatic annotation of the electronic document may include a variety of formats as shown in Figures 2B and 2C. The annotation taught by *Graham* is performed automatically based on the contents of a user profile. Additionally, *Graham* teaches that a user may select an already annotated (highlighted) keyword in the electronic document with a mouse to display a balloon that contains addition information for the keyword, such as the concept name associated with the keyword from the user profile. This is not an automatic search process. To the contrary, this process described by *Graham* in this portion is merely retrieving additional information from the user profile for the keyword. *Graham* also teaches that a summary view of the document can be generated which contains an outline of the concepts of interest and keywords found in the document. *Graham* does not teach

or suggest that a user can select any portion of text from an electronic document after the electronic document is displayed and automatically searching for items relevant to the selected text in response to the user input selecting the text.

The following portion of *Graham* describes the processing of an annotation agent:

The processing of annotation agent 508 is preferably a run-time process. The annotations are not preferably pre-inserted into the text but are rather generated when user 504 requests document 502 for browsing. Thus, this is preferably a dynamic process. Annotation agent 508 may also, however, operate in the background as a batch process.

The annotation added by annotation agent 508 depends on concepts of interest selected by user 504. User 504 also inputs information used by annotation agent 508 to identify locations of discussion of concepts of interest in document 502. In a preferred embodiment, this information defines the structure of a Bayesian belief network. The concepts of interest and other user-specific information are maintained in a user profile file 516. User 504 employs a profile editor 518 to modify the contents of user profile file 516.

*Graham*, column 5, lines 3-16. (emphasis added)

This portion of *Graham* shows that annotations are generated when a user opens a document for browsing and that the annotation depends on the selected concepts of interest maintained in a user profile file. Thus, *Graham* only teaches automatic annotating based on the contents of a user profile. *Graham* does not teach that a user tags a beginning point and an ending point of any portion of text in the electronic book and this user input is used in the automatic search for items relevant to the selected text.

The Final Office Action refers to the following portion of *Graham* in the rejection of independent claims 1, 18, 20 and 21:

If a concept has been selected for editing, its name appears in a concept name box 813. The portion of the belief network pertaining to the selected concept is shown in a belief network display window 814. Belief network display window 814 shows the selected concept, the subconcepts which have been defined as relating to the selected concept and the percentage values associated with each relationship. The user may add a subconcept by selecting a subconcept add button 815. The user may edit a subconcept by selecting the subconcept in belief network display window 814 and then selecting a subconcept edit button 816. A subconcept remove button 818 permits the user to delete a subconcept from the belief network.

Selecting subconcept add button 815 causes a subconcept add window 820 to appear. Subconcept add window 820 includes a subconcept name box 822 for entering the name of a new subconcept. A slider control 824 permits the user to select the percentage value that defines the probability of the selected concept appearing given that the newly selected subconcept appears. A keyword list 826 lists the keywords and key



phrases which indicate discussion of the subconcept. The user adds to the list by selecting a keyword add button 828 which causes display of a dialog box (not shown) for entering the new keyword or key phrase. The user deletes a keyword or key phrase by selecting it and then selecting a keyword delete button 830. Once the user has finished defining the new subconcept, he or she confirms the definition by selecting an OK button 832. Selection of a cancel button 834 dismisses subconcept add window 820 without affecting the belief network contents or structure. Selection of subconcept edit button 816 causes display of a window similar to subconcept add window 820 permitting redefinition of the selected subconcept.

By selecting whether a background learning checkbox 836 has been selected, the user may enable or disable the operation of profile updating stage 624. A web autofetch check box 838 permits the user to select whether or not to enable an automatic web search process. When this web search process is enabled, whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web search tool such as Alta Vista TM, is employed to look on the World Wide Web for documents containing the keyword or key phrase. A threshold slider control 840 is provided to enable the user to set a threshold relevance level for this autofetching process.

FIGS. 9A-9B depict a user interface for providing feedback in accordance with one embodiment of the present invention. User 504 may select any text and call up a first feedback window 902. The text may or may not have been previously identified by the annotation system as relevant. In first feedback window 902 shown in FIG. 9A, user 504 may indicate the concept to which the selected text is relevant. First feedback window 902 may not be necessary when adjusting the relevance level for a keyword or key phrase that is already a part of belief network 700. After the user selects a concept in first feedback window 902, a second feedback window 904 is displayed for selecting the degree of relevance. Second feedback window 904 in FIG. 9B provides three choices for level of relevance: good, medium (not sure), and bad. Alternatively, a slider control could be used to set the level of relevance. If the selected text is not already a keyword or key phrase in belief network 700, a new subconcept is added along with the associated new keyword or key phrase. If the selected text is already a keyword or key phrase, above, probability values within belief system 700 are modified appropriately in response to this user feedback. (emphasis added)

*Graham*, column 7, line 26 through column 8, line 12. (emphasis added)

This portion of *Graham* only teaches that a user interface has an automatic web search process, which a user may enable or disable. *Graham* does not teach or suggest automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input, as recited in claims 1, 18, 20 and 21. As stated previously, the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and the selected text is identified by a user after the electronic book is displayed. To the contrary, *Graham's* web search is based on the contents of a user profile. In *Graham*, if a user

selects the automatic web search process option, an electronic document is searched based on the contents of a user profile and in response to opening the electronic document. A keyword or key phrase from the user profile, that is found when the electronic document is opened for browsing, may initiate an automatic web search process if the keyword or key phrase is found frequently near a defined concept. The search is not in response to receiving user input as recited in claims 1, 18, 20 and 21.

Additionally, this portion of *Graham* refers to Figure 8, Figure 9A and Figure 9B. Figure 8 is a user interface for defining a user profile (see *Graham*, column 2, lines 46-48). The user interface allows concepts to be defined in a user profile. The user interface provides the method for adding, editing and removing concepts of interest in a user profile. Figure 8 of *Graham* follows:

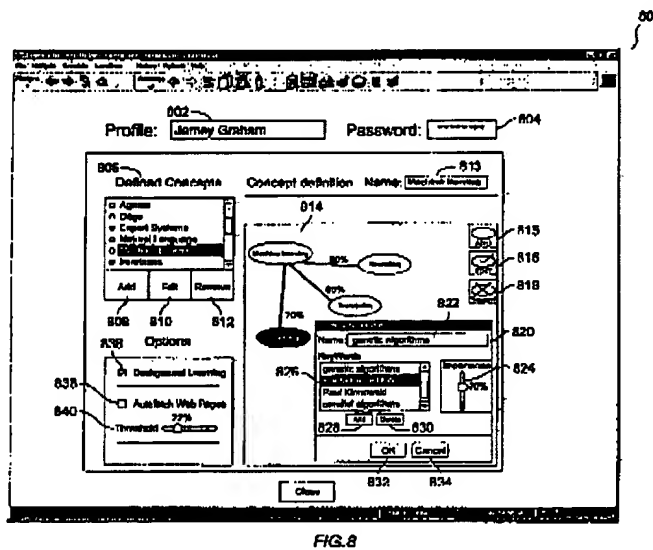


FIG. 8

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*Graham, Figure 8.*

Figure 8 of *Graham* shows that a user can add a concept by entering text into concept name box 813 or add a subconcept by entering text into subconcept name box 820. A list of the defined concepts are displayed in box 806. A user may select a defined concept to edit or remove from the list. *Graham* also teaches searching for web pages containing a concept. To the

contrary, claims 1, 18, 20 and 21 recite receiving a user input selecting the text from an electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed; and automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input. In other words, in the present invention, a user may select any portion of text in an electronic book as the user is reading the electronic book and search for items relevant to the selected text in response to selecting the text. For example, a user may be reading an electronic book and not know information about a breed of a dog, for instance. The user can select the text "Basenji puppies" by tagging the "B" in "Basenji" and the "s" in "puppies" (i.e. beginning and ending point of any portion of text in the electronic book) while reading the electronic book and a search for items relevant to the selected text is automatically initiated. Thus, a user can find out information on "Basenji puppies", for example, while reading the electronic book. *Graham* does not teach or suggest these features as recited in claims 1, 18, 20 and 21.

Additionally, Figure 9A and Figure 9B of *Graham* show a user interface for providing feedback. A user may select text and identify the selected text as being relevant to a previously defined concept of interest. To the contrary, claims 1, 18, 20 and 21 recite automatically initiating a search for items relevant to the selected text in response to the user input selecting the text. Thus, *Graham* does not teach or suggest the features of claims 1, 18, 20 and 21.

In view of the above, Applicants respectfully submit that *Graham* does not teach each and every feature of independent claims 1, 18, 20 and 21, as is required under 35 U.S.C § 102(e). Additionally, *Graham* does not teach each and every feature of dependent claims 2-7 and 9-10 at least by virtue of their dependency on claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-7, 9-10 and 18, 20 and 21 under 35 U.S.C § 102(e).

Furthermore, *Graham* does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. *Graham* actually teaches away from the presently claimed invention because it teaches annotating text and searching for text related to concepts and keywords in a user profile opposed to a user selecting any portion of text in an electronic document and automatically searching for items relevant to the selected text in response to the user selecting the text as in the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement *Graham* and method for a user

to select any portion of text in an electronic document and automatically searching for items relevant to the selected text in response to the user selecting the text, one of ordinary skill in the art would not be led to modify *Graham* to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify *Graham* in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

#### A.2. Claims 11, 13-16 and 19

As to independent claims 11 and 19, the Final Office Action states:

With regard to claims 11 and 19:

*Graham* discloses a computer-implemented method for researching highlighted or annotated text in an electronically stored document (or electronic book), which contains plurality of pages including table of contents (see Figs. 2A-2D, 3, 4, 9A and 9B).

The method includes among other things, designating, or tagging the text to use in a search based on a user selected beginning and ending tags of any portion of text located in an electronic document (column 8, lines 13-31); the method also includes responsive to designating the text in the electronic document to use in search, placing the text in a data structure, wherein the data structure is a search profile (column 5, lines 9-16, column 6, lines 31-45);

Preparing and transmitting (via document browser 506) the selected highlighted text to be searched by a web search tool such as such as Alta Vista™ (column 7, lines 46-57).

The method further includes receiving (via document browser 506) the search result from the web search (column 7, lines 46-57).

Final Office Action dated December 7, 2004, pages 6-7.

Claim 11, which is representative of the other rejected independent claim 19 with regard to similarly recited subject matter, reads as follows:

11. A method in a data processing system for searching text, the method comprising:  
designating the text to use in a search based on a user selected beginning point and a user selected ending point of any portion of text located in an electronic document;  
responsive to designating the text in the electronic document to use in the search,  
placing the text in a data structure, wherein the data structure is a search profile;  
transmitting the data structure to a search engine; and  
receiving results from the search engine. (emphasis added)

*Graham* does not teach or suggest designating the text to use in a search based on a user selected beginning point and a user selected ending point of any portion of text located in an

electronic document. To the contrary, *Graham* only teaches automatically searching for keywords in a user profile. As discussed above, *Graham* only searches the web for keywords or key phrases in a user profile if the keywords or key phrases are found frequently near where a defined concept is determined to be discussed. The concept is defined in a user profile file. *Graham* does not teach or suggest a method for any selected portion of text to be used in a search. To the contrary, only frequently found keywords or key phrases may initiate the automatic autofetch function of *Graham*. Thus, *Graham* does not teach or suggest the features of claims 11 and 19.

The Final Office Action refers to the following portions of *Graham* in the rejection of independent claims 11 and 19:

The annotation added by annotation agent 508 depends on concepts of interest selected by user 504. User 504 also inputs information used by annotation agent 508 to identify locations of discussion of concepts of interest in document 502. In a preferred embodiment, this information defines the structure of a Bayesian belief network. The concepts of interest and other user-specific information are maintained in a user profile file 516. User 504 employs a profile editor 518 to modify the contents of user profile file 516.

*Graham*, column 5, lines 9-16. (emphasis added)

The structure of belief system 700 is however also modifiable during use of the annotation system. The modifications may occur automatically in the background or may involve explicit user feedback input. The locations of concepts of interest determined by pattern identification stage 620 are monitored by profile updating stage 624. Profile updating stage 624 notes the proximity of other keywords and key phrases within each analyzed document to the locations of concepts of interest. If particular keywords and key phrases are always near a concept of interest, the structure and contents of belief system 700 are updated in the background without user input by profile updating stage 624. This could mean changing probability values, introducing a new connection between a subconcept and concept, or introducing a new keyword or key phrase.

*Graham*, column 6, lines 31-45. (emphasis added)

By selecting whether a background learning checkbox 836 has been selected, the user may enable or disable the operation of profile updating stage 624. A web autofetch check box 838 permits the user to select whether or not to enable an automatic web search process. When this web search process is enabled, whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web search tool such as Alta Vista™ is employed to look on the World Wide Web for documents containing the keyword or key phrase. A threshold slider control 840 is provided to enable the user to set a threshold relevance level for this autofetching process.

*Graham*, column 7, lines 46-57. (emphasis added)

FIG. 10 depicts a portion of an HTML document 1000 processed in accordance with one embodiment of the present invention. A sentence including relevant text is preceded by an a <RH.ANOH.S . . . > tag 1002 and followed by an </RH.ANOH.S > tag 1004. The use of these tags facilitates the annotation mode where complete sentences are highlighted. The <RH.ANOH.S . . . > tag 1002 includes a number indicating which relevant sentence is tagged in order of appearance in the document. Relevant text within a so-tagged relevant sentence is preceded by an <RH.ANOH . . . > tag 1006 and followed by an </RH.ANOH> tag 1008. The <RH.ANOH . . . > 1006 tag include the names of the concept and subconcept to which the annotated text is relevant, an identifier indicating which relevant sentence the text is in and a number which identifies which annotation this is in sequence for a particular concept. An HTML browser that has not been modified to interpret the special annotation tags provided by the present invention will ignore them and display the document without annotations.

*Graham*, column 8, lines 13-31. (emphasis added)

These portions of *Graham* teach that a user interface has an automatic web search process, which a user may enable or disable. *Graham* does not teach or suggest designating the text to use in a search based on a user selected beginning point and a user selected ending point of any portion of text located in an electronic document, as recited in claims 11 and 19. To the contrary, *Graham's* web search is based on the contents of a user profile. A keyword or key phrase from the user profile, that is found when a document is opened for browsing, may initiate an automatic web search process if the keyword or key phrase is found frequently near a defined concept. Thus, *Graham's* search is responsive to opening an electronic document. *Graham's* search is not in response to designating the text to use in a search based on a user selected beginning point and a user selected ending point of any portion of text located in an electronic document as recited in claims 11 and 19. Additionally, the Final Office Action refers to Figure 10, which shows a portion of an HTML document processed by *Graham's* invention. *Graham's* invention places tags in a HTML file to identify concepts or keywords from the user profile that are located in the HTML file. If the browser is modified to interpret the tags, then the HTML document is automatically annotated when it is opened for display. Thus, *Graham* does not teach or suggest the features of claims 11 and 19.

In view of the above, Applicants respectfully submit that *Graham* does not teach each and every feature of independent claims 11 and 19, as is required under 35 U.S.C § 102(e). Additionally, *Graham* does not teach each and every feature of dependent claims 12-16 at least

by virtue of their dependency on claim 11. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 11-16 and 19 under 35 U.S.C § 102(e).

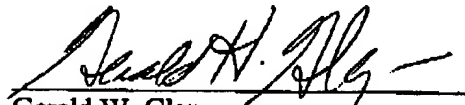
**A.3. Claims 7 and 12**

In addition to the above, Appellants respectfully submit that claims 7 and 12 are independently distinguishable from the *Graham* reference. Claim 7 depends from claim 1 and additionally recites that the selected text is a user created note associated with at least a portion of the electronic book. Claim 12 depends from claim 11 and additionally recites that the text includes a user created note associated with the text. The specification of the present invention on page 14, lines 9-18, states that a note contains text, such as comments about a portion of the electronic book or references related to the electronic book. A note can be associated with a portion of the electronic book or the entire electronic book. *Graham* does not teach, suggest or mention creating notes for an electronic document or using the text from a note in a search. The Final Office Action refers to column 3, lines 57 through column 4, lines 17 of *Graham* (previously shown and discussed above) in the rejection of claims 7 and 12. This portion of *Graham* does not teach or suggest the features as recited in claims 7 and 12. Therefore, claims 7 and 12 are believed distinguished from the *Graham* reference.

**CONCLUSION**

In view of the above, Appellants respectfully submit that claims 1-7, 9-16 and 18-21 define over the prior art of record. Appellants therefore respectfully request the Board of Patent Appeals and Interferences to overturn the rejection of claims 1-21 under 35 U.S.C. 103(a).

Respectfully submitted,



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**CLAIMS APPENDIX**

The text of the claims involved in the appeal are:

1. (Previously Presented) A method in a data processing system for researching text in an electronic book, the method comprising:

receiving a user input selecting the text from the electronic book, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed; and automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input.

2. (Original) The method of claim 1, wherein at least one item is at least one of a Web page, a Web site, another electronic book, an electronic document, and a universal resource locator.
3. (Original) The method of claim 1 further comprising:  
storing the selected text in a data structure.
4. (Original) The method of claim 2, wherein data structure is a search profile.
5. (Original) The method of claim 1, wherein the selected text is highlighted text.
6. (Original) The method of claim 5, wherein the highlighted text is text in a different color from unselected text, bolded text, and text with a different font type from unselected text.

7. (Previously Presented) The method of claim 1, wherein the selected text is a notated passage of text in the electronic book and wherein the notated passage of text is a user created note associated with at least a portion of the electronic book.
8. (Canceled)
9. (Original) The method of claim 1 further comprising:  
receiving a result from the searching; and  
presenting the result.
10. (Original) The method of claim 9, wherein the step of receiving a result is initiated using a search engine.
11. (Previously Presented) A method in a data processing system for searching text, the method comprising:  
designating the text to use in a search based on a user selected beginning point and a user selected ending point of any portion of text located in an electronic document;  
responsive to designating the text in the electronic document to use in the search, placing the text in a data structure, wherein the data structure is a search profile;  
transmitting the data structure to a search engine; and  
receiving results from the search engine.

12. (Previously Presented) The method of claim 11, wherein the text includes a user created note associated with the text.
13. (Original) The method of claim 12, wherein the search profile includes search criteria.
14. (Previously Presented) The method of claim 11, wherein the electronic document is at least one of an electronic book and a Web page.
15. (Previously Presented) The method of claim 11 further comprises:  
downloading the results from the search engine; and  
displaying the results from the search engine.
16. (Previously Presented) The method of claim 11, wherein designating the text further comprises highlighting the text in the electronic document.
17. (Canceled)
18. (Previously Presented) A data processing system for researching highlighted text in an electronic book, a data processing system comprising:  
receiving means for receiving a user input selecting the text from the electronic book to form selected text, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed; and

initiating means for automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input.

19. (Previously Presented) A data processing system for searching text, the data processing system comprising:

designating means for designating the text to use in a search based on a user selected beginning point and a user selected ending point of any portion of text located in an electronic document;

responsive to designating the text in the electronic document to use in the search, placing means for placing the text in a data structure, wherein the data structure is a search profile;

transmitting means for transmitting the data structure to a search engine; and

receiving means for receiving results from the search engine.

20. (Previously Presented) A data processing system comprising:

a bus system;

a communication unit connected to the bus system;

a memory connected to the bus system, wherein the memory includes a set of instructions; and

a processing unit connected to the bus system, wherein the processing unit executes the set of instruction to receive a user input selecting the text from the electronic book to form selected text, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed; and automatically initiate a search for at least one item relevant to the

selected text in response to receiving the user input.

21. (Previously Presented) A computer program product in a computer readable medium for researching highlighted text in an electronic book, the computer program product comprising:

first instructions for receiving a user input selecting the text from the electronic book to form selected text, wherein the user input tags a beginning point and an ending point of any portion of text in the electronic book to form selected text and wherein the selected text is identified by a user after the electronic book is displayed; and

second instructions for automatically initiating a search for at least one item relevant to the selected text in response to receiving the user input.

**EVIDENCE APPENDIX**

There is no evidence to be presented.

**RELATED PROCEEDINGS APPENDIX**

There are no related proceedings.